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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,124	01/08/2002	Frank Butaric	CRD-0903	5306

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AUDLEY A. CIAMPORCERO JR.
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER MILLER, CHERYL L

ART UNIT 3738	PAPER NUMBER 5
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DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

Office Action Summary

Application No.

10/041,124

Applicant(s)

BUTARIC ET AL.

Examiner

Cheryl Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 14-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Group I., claims 1-13 in Paper No. 4 is acknowledged. The traversal is on the ground(s) that different classification is not a basis for restricting multiple groups. This is not found persuasive because the different classification of the groups is not the basis of the restriction. The examiner refers applicant to paper no. 3, wherein the basis for restriction included reasons for example, product and process of use, combination subcombination, subcombinations usable together, and unrelated inventions. The fact that the different groups are classified in separate subclasses was not the basis for restriction, but merely support for the restriction.

The requirement is still deemed proper and is therefore made FINAL.

Specification

The abstract of the disclosure is objected to because it contains the legal terminology "the invention" and "the present invention". Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Drawings

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The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the extension prosthesis in combination with the bypass prosthesis and sealing prosthesis, as claimed in claim 7, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 26 shown in fig.2, 31 shown in fig.3, and 43A shown in fig.15. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites, "at least two struts that are unattached on the proximal end." It is unclear as to what the struts are unattached to.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 and 10-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Dehdashtian (USPN 6,344,056 B1). Dehdashtian discloses a system for bypassing an aneurysm comprising a bypass prosthesis (34) and an extension prosthesis (42), wherein the bypass prosthesis (34) is a stent/graft (as seen in fig.1). Dehdashtian discloses an extension prosthesis (42) being a stent/graft (as seen in fig.1), where the proximal end is engagable with the bypass prosthesis and comprises at least one hoop (stent hoops, fig.1) with at least two struts. Dehdashtian discloses a sealing prosthesis (20) configured to receive a proximal end of the bypass prosthesis (34). Dehdashtian discloses at least one anchor positioned in a distal portion of the extension prosthesis (ends of stent seen in fig.1). Dehdashtian discloses at least one or two markers on the distal portion of the bypass prosthesis and the proximal portion of the extension prosthesis (col.11, lines 1-5).

Claims 1-5 and 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Dereume et al. (USPN 5,639,278). Dereume discloses a system for bypassing an aneurysm comprising a bypass prosthesis (101) and an extension prosthesis (108), wherein the bypass prosthesis a stent/graft (fig.7) and a distal open end configured to receive an extension prosthesis (fig.22). Dereume discloses an extension prosthesis (108) being a stent/graft (fig.1-6; col.12,

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lines 6-9), where the proximal end is engagable with the bypass prosthesis (fig.22) and comprises at least one hoop with at least two struts. Dereume discloses at least one connector, the connector comprising a leg having a knobbed tip (col.11, lines 25-30; col.12, lines 1-5, 15-22). Dereume discloses at least one anchor positioned in a distal portion of the extension prosthesis (130, col.12, lines 1-5). Dereume discloses at least one or two markers on the distal portion of the bypass prosthesis and the proximal portion of the extension prosthesis (col.14, lines 38-55).

Claims 1-6 and 10-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Ryan et al. (application no. 09/502,942 Pub No. US 2002/0156521 A1). Ryan discloses a system for bypassing an aneurysm comprising a bypass prosthesis (64, 132) and an extension prosthesis (66, 68, 140), wherein the bypass prosthesis a stent/graft (80, 82) and a distal open end configured to receive an extension prosthesis (fig.3, 9C, 10). Ryan discloses an extension prosthesis (66, 68, 140) being a stent/graft (fig.7), where the proximal end is engagable with the bypass prosthesis and comprises at least one hoop with at least two struts (fig.7). Ryan discloses a sealing prosthesis (62) configured to receive a proximal end of the bypass prosthesis. Ryan discloses at least one anchor (212) positioned in a distal portion of the extension prosthesis (fig.10). Ryan discloses at least one or two markers (marker band 138; 0069, 0071, 0072) on the distal portion of the bypass prosthesis and the proximal portion of the extension prosthesis.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dehdashtian (USPN 6,344,056 B1). Dehdashtian discloses a sealing prosthesis (20) proximal of the bypass prosthesis (34), the sealing prosthesis comprising a stent partially covered with a graft (fig.6,7,8), however the stent remains uncovered on a proximal end instead of a distal end (col.9, lines 20-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a partially covered stent, wherein the uncovered portion lies on the distal end, since it has been held that a mere relocation of parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (703) 305-2812. The examiner can normally be reached on Monday through Friday from 7:30am to 5:00pm.

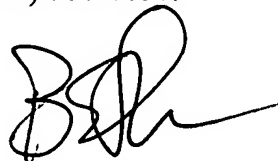
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Cheryl Miller

May 30, 2003

BRUCE SNOW
PRIMARY EXAMINER